UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,914	03/03/2006	Klaus Hoffmann	2003P13487WOUS	3819

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EXAMINER
PHUNG, LUAT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/570,914	HOFFMANN, KLAUS
	Examiner	Art Unit
	LUAT PHUNG	2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 March 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>10-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>10-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>03 March 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claims 12, 13, 15, 16 and 22 are objected to because of the following

informalities:

Claim 12 recites "the mapping is occurs" in lines 2 and 4. It is suggested

to delete --is--.

Claim 13, line 2, it is suggested to change "an" to --a-- before "200 OK" in

line 2. The same objection applies to claim 16.

Claim 15, line 2, it is suggested to change "Display field" in FROM header

to --Display name--, same as CONTACT header later in the same claim.

Claim 22 should conclude with a period.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived
> by the manner in which the invention was made.

3.   This application currently names joint inventors. In considering

patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that

the subject matter of the various claims was commonly owned at the time any

inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a

later invention was made in order for the examiner to consider the applicability of

35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35

U.S.C. 103(a).

4.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1,

148 USPQ 459 (1966), that are applied for establishing a background for

determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5.   Claims 10, 11 and 18-22 are rejected under U.S.C. 103(a) as being

unpatentable over Samarasinghe, et al (US Pub. 2004/0028080), in view of

Crockett, et al (US Pub. 2004/0161083).

Regarding **claim 10**, Samarasinghe discloses a method for supporting a

Name Delivery feature between a TDM network connected to SIP CENTREX

configurations, the Name Delivery feature including name information (Fig. 2;

para. 7, 65), comprising:

mapping between the name information located in a plurality of

information elements of a transmission protocol and a SIP protocol (Caller Name

parameter per para. 65 and Table 1; Border Element BE providing mapping

between SIP and a protocol such as ISUP or H.323 per para. 22, 39)

Samarasinghe discloses all of the subject matter except determining from subscriber related information whether to suppress or approve the name information in the SIP protocol. Crockett from the same or similar fields of endeavor discloses determining from subscriber related information whether to suppress or approve the name information in the SIP protocol (SIP Invite request containing calling party name if presentation not restricted per para. 88, 90). Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention to combine Samarasinghe's network of SIP and with Crockett's population of name information by mapping only name information is not restricted. The motivation for doing so would have been to implement the calling name feature.

Regarding **claim 11**, Samarasinghe further discloses wherein the Name Delivery feature includes a Calling Name sub-feature (para. 65). Samarasinghe does not explicitly disclose a Connected Name sub-feature. However, it is well known in the art that Connected Name is coupled with Calling Name, and both are often provided together by communication systems.

Regarding **claim 18**, the combination of Samarasinghe and Crockett discloses substantially all of the subject matter. Samarasinghe does not explicitly disclose further comprising providing a SIP proxy server connected to a database. However, Crockett discloses the SCP acting as a SIP server accessing the CNAME database (para. 79, 88). Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention to

implement the SIP server as suggested by Crockett in the network of

Samarasinghe in order to access the name information to support the feature.

Regarding **claim 19**, the combination of Samarasinghe and Crockett

discloses substantially all of the subject matter. Samarasinghe does not explicitly

disclose wherein the database includes subscriber related data for a SIP

CENTREX configuration subscriber and a TDM network subscriber. However,

Crockett discloses the database supporting all name queries (para. 79, 88).

Thus it would have been obvious to the person of ordinary skill in the art at the

time of the invention to include both SIP and TDM subscribers in the database as

suggested by Crockett in the network of Samarasinghe in order to access the

name information to support the feature.

Regarding **claim 20**, Samarasinghe in view of Crockett further discloses

wherein the mapping occurs in a Media Gateway Controller (MGC). (Fig. 2,

elements 26; para. 19, 22, 39)

Regarding **claim 21**, the combination of Samarasinghe and Crockett

discloses substantially all of the subject matter. Samarasinghe does not explicitly

disclose wherein the proxy server determines whether the name information is

suppressed or approved. Crockett from the same or similar fields of endeavor

discloses determining from subscriber related information whether to suppress or

approve the name information in the SIP protocol (para. 88, 90). Thus it would

have been obvious to the person of ordinary skill in the art at the time of the

invention to combine Samarasinghe's network of SIP and with Crockett's

population of name information by mapping only name information is not

restricted. The motivation for doing so would have been to implement the calling

name feature.

Regarding claim **22**, Samarasinghe in view of Crockett further discloses

wherein the transmission protocol is selected from the group consisting of:

BICC/ISUP protocol, H.323 protocol, DSS1 protocol, and a mobile

communication application supporting protocol. (para. 39)

6.   Claims 12-17 are rejected under U.S.C. 103(a) as being unpatentable

over Samarasinghe, et al in view of Crockett, et al, and further in view of

Venkataramanan (Enhancements to Asserted Identity to Enable Called Party

Name Delivery using SIP, Internet Draft, IETF, draft-venkatar-sipping-called-

name-00.txt, June 2003).

Regarding **claim 12**, the combination of Samarasinghe and Crockett

discloses all of the subject matter except:

wherein the mapping occurs between the name information of a first sub-

feature into a first information element of the SIP protocol, and

wherein the mapping occurs between the name information of a second

sub-feature into a second information element of the SIP protocol.

It is well known in the art that the SIP standard RFC 3261 sec. 20.20

specifies that the From header field of the SIP Invite message contains a display

name that indicates the human originator of the request. Thus it would have

been obvious to one of ordinary skill in the art at the time of the invention to map

the Calling Name sub-feature to the Display field in From header of the SIP Invite

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message in the network of Samarasinghe and Crockett in order to implement the calling name feature.

Furthermore Venkataramanan from the same or similar fields of endeavor discloses an option of using display name in the Contact header in a SIP 200-class response to convey the Connected Name sub-feature. (Overview section, first para.) Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention to support the Connected Name sub-feature by mapping it to the display name of the Contact header in a "200 OK" SIP message as suggested by Venkataramanan in the network of Samarasinghe and Crockett. The motivation for doing so would have been to implement the connected name feature. (It is noted that Venkataramanan is a proposed RFC arguing for using another SIP parameter to implement the Connected feature; however, this approach is not supported and this RFC is now RIP.)

Claims 13-17 are rejected for the same reason as recited above for claim 12.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form 892).

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luat Phung whose telephone number is 571-270-3126. The examiner can normally be reached on M-Th 7:30 AM - 5:00 PM, F 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. P./

Examiner, Art Unit 2616

/Huy D. Vu/

Supervisory Patent Examiner, Art Unit 2616